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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) AMK-2802-34
Application Number 10/510,123	Filed October 4, 2004	
First Named Inventor Understein		
Art Unit 3694	Examiner B. Fertig	

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ Applicant/Inventor

☐ Assignee of record of the entire interest. See 37 C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96)

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Registration number if acting under 37 C.F.R. § 1.34 _____

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June 24, 2009
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.*

☒ *Total of 1 form/s are submitted.

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REASONS FOR REVIEW

Claims 1-9 and 11-17 were rejected under 35 U.S.C. §103(a) over U.S. Published Patent Application No. 2002/0026396 to Dent in view of U.S. Published Patent Application No. 2001/0034676 to Vasic. This rejection is respectfully traversed.

Claim 1 defines a method of processing funds between a transferor and a transferee. At least the transferor has a transferor deposit sub-account administered by a depository administrator. The depository administrator maintains a master account at a financial institution. The transferor accesses the depository administrator and requests a transfer or hold of funds in the deposit sub-account to or for the benefit of the transferee. The depository administrator processes the funds between the transferor deposit sub-account and a transferee deposit sub-account, wherein each of the sub-accounts forms part of the master account such that a transfer of funds between sub-accounts does not affect a balance in the master account. As such, the depository administrator is capable of administering an entirely independent system under a single master account at a financial institution while benefiting from the convenience and protection offered by the financial institution.

The Office Action recognizes that Dent lacks at least the claimed sub-accounts that form part of the master account. In this context, however, the Office Action contends that Vasic discloses such subject matter and that it would have been obvious to incorporate such sub-accounts into the system disclosed in Dent in view of the Vasic publication. Applicant respectfully submits, however, that this conclusion is misplaced.

The Vasic publication describes a method for allowing employees to receive payroll and to access payroll on demand, possibly in advance. In particular, the system enables a third party to receive a request from an employee for payroll access, forwards the requested funds to the employee on demand, and deducts the forwarded funds from the employee's payroll check. In paragraphs [0026] and [0056], Vasic references a master account as a principal payroll access resource and describes a secondary payroll access resource as a sub-account of the master account. In this context, Vasic contemplates that the payroll access company can keep a large master account with funds sufficient to cover payroll access for numerous employees and have

separate “sub accounts” for individual employees that remain empty and inactive until an employee requests access. In this context, however, Vasic only describes transfers of funds from the master account into a sub-account from which an employee draws forwarded wages. Vasic does not in any manner contemplate or suggest that employees can transfer funds to each other between the sub-accounts. Vasic additionally describes that the sub-account “actually has no funds until the sub-account is activated by using the [ATM] card and the funds are automatically transferred from the master account or alternatively transferred or wired with associated fees.” See paragraph [0056]. That is, funds are never transferred between sub-accounts, but rather are only transferred from the employer’s master account administered by the payroll service to the sub-account accessible by the employee. Reference to “transferring funds” in paragraph [0063] similarly merely refers to transferring funds from the employer’s master account to a sub-account accessible by an employee.

Applicant thus respectfully submits that the Vasic publication similarly lacks the sub-account features of the invention, particularly relating to transferring funds between sub-accounts. As a consequence, Applicant submits that Dent in view of Vasic falls short of the claimed invention and that the rejection of independent claim 1 is misplaced.

In the “Response to Arguments” section in the final Office Action, the Examiner contends that “the claim language does not positively recite transferring step, but instead recites a limitation characterizing the sub-account.” To the contrary, however, step (d) in claim 1 specifically recites that the depository administrator processes the funds between the transferor deposit sub-account and the transferee deposit sub-account. Since the Vasic publication does not disclose any capability of processing funds between different sub-accounts, Applicant submits that the conclusions in the Office Action are misplaced and the rejection should be withdrawn. The mere capability of transferring funds between sub-accounts in the Vasic patent is not sufficient to support the conclusion of obviousness. See, e.g., *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)(“The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.”). See also, *Ex parte Levengood*, 28

USPQ2d 1300, 1301–02 (B.P.A.I. 1993) (“That which is within the capabilities of one skilled in the art is not synonymous with obviousness. . .”).

In paragraph 8, the Office Action notes that “Dent teaches the transfer of funds between accounts.” In contrast with the claimed invention, however, the financial service center 102 in Dent requires that the transaction participants provide access to independent accounts. See, for example, paragraph [0014], [0046], [0050], [0094], [0123] and others. Since the Vasic publication does not even remotely suggest an ability or desire to transfer funds between sub-accounts, Applicant submits that those of ordinary skill in the art would not look to Vasic to improve the system disclosed in Dent. Even under the Supreme Court’s *KSR* decision, the combination of Dent and Vasic would not yield predictable results since the combined teachings do not perform the same functions as they do separately. That is, since the Vasic system neither discloses nor suggests an ability to transfer funds between sub-accounts, incorporating Vasic into the Dent system would require the Vasic system to perform in a way that it does not perform separately. As such, Applicant submits that the rejection is misplaced.

With regard to dependent claims 2-9 and 11-15, Applicant submits that these claims are allowable at least by virtue of their dependency on an allowable independent claim. Moreover, claim 6 recites that step (d) is practiced by holding the funds in the transferor deposit sub-account until receiving confirmation that an event has occurred. In contrast with the claimed “hold” feature, Dent merely describes an authorization button to authorize a particular transaction. Indeed, Dent is silent with regard to any such holding feature. As would be apparent to those of ordinary skill in the art, “held” funds are significantly distinguishable from funds not yet transferred. In the final Office Action, the Examiner contends that “Applicant has provided the Examiner with neither reasoning nor evidence in support of the argument that the authorization feature taught by Dent in paragraph 123 does not fairly suggest the holding features recited in claim 6.” In this context, the definition found by the Examiner of the term “hold” is inconsistent with the use of the term in the present specification. As described in the specification, funds that are held in a transferor’s deposit sub-account are made unavailable to the

transferor, giving the transferee assurance that the funds will be transferred upon the occurrence of a predefined condition. See, for example, page 9, lines 16-28. In the Dent publication, prior to selecting the authorization button, the funds remain available to the account holder. As such, by Applicant's specific definition of held funds, the funds in the Dent publication do not suggest the feature of claim 6. As noted, this distinction would be readily apparent to those of ordinary skill in the art. Claims 7-9 further define this feature. These additional definitions are similarly distinguishable from merely selecting an authorization button.

Independent claim 16 defines a computer system for processing funds between a transferor and a transferee. A system server processes funds between a transferor deposit sub-account and a transferee deposit sub-account, each of which forms part of a master account such that the transfer of funds between the sub-accounts does not affect a balance in the master account. As discussed above, Vasic lacks any disclosure or suggestion of transferring funds between sub-accounts, but rather merely discloses only a transfer of funds from an employer's master account to an employee's sub-account. As a consequence, Vasic is not relevant to the claimed invention. For reasons similar to those discussed above with regard to claim 1, Applicant submits that the rejection of claim 16 is also misplaced.

Claim 17 defines a computer program embodied on a computer-readable medium for processing funds between a transferor and a transferee. Claim 17 defines "means for" carrying out the method of claim 1, and Applicant submits that claim 17 is allowable for reasons similar to those discussed above with regard to claim 1.

Withdrawal of the rejection is respectfully requested.